| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/685,406 | 10/09/2000 | Jin-Hak Bae | 51876.P201 | 6028 |

| | | EXAMINER |
|---|---|---|
| 7590 | 11/18/2004 | , LUDWIG, MATTHEW J |

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Los Angeles, CA 90025

| ART UNIT | PAPER NUMBER |
|---|---|
| 2178 | |

DATE MAILED: 11/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on _10 June 2004_.

2a)☒ This action is **FINAL**.          2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) _1-15_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1,3,4,6-10,12 and 15_ is/are rejected.

7)☒ Claim(s) _5,11,13 and 14_ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

## DETAILED ACTION

1.      This action is responsive to communications. Amendment A received June 10, 2004.

2.      Claims 1-15 are pending in the case. Claims 1, 10, and 15, are independent claims.

Applicant has cancelled dependent claim 2.

3.      The rejection of claims 1-4, and 6-15 under 35 U.S.C. 103(a) as being unpatentable over

Fin has been withdrawn pursuant to Applicant's amendment. The rejection of claim 5 under 35

U.S.C. 103(a) as being unpatentable over Tabuchi has been withdrawn pursuant to Applicant's

amendment.

### *Claim Objections*

4.      Claims 3 and 4 are objected to because of the following informalities: Applicant has

cancelled dependent claim 2, therefore, dependent claims 3 and 4 incorrectly depend upon a

cancelled claim. Appropriate correction is required.

### *Claim Rejections - 35 USC § 103*

5.      The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

6.      **Claims 1, 3, 4, 6-10, 12, and 15, are rejected under 35 U.S.C. 103(a) as being**

**unpatentable over Everingham USPN 6,327,611 filed (11/4/1998) in view of Murakami et**

**al., USPN 6,725,221 filed (6/25/2001).**

**In reference to independent claim 1**, Everingham teaches:

The manager can create one document and an ordered list of recipients. The document is sent out to the first recipient. Each recipient in turn adds a status to the message and, when the recipient is finished, the message is then routed to the next recipient in the list (compare to "*a first user interface module of the plurality of the clients for generating editing instructions by receiving data from a user*"). See column 3, lines 25-56. The reference suggest generating editing instructions if it is determined the user is on a list and if he/she is granted permission to modify a document.

The originator allows the recipient to edit the original document or add only comments to the original. The originator also sets time out preferences for each recipient (compare to "*a first document manager module in each of the plurality of the clients for converting the editing instruction into a message and transmitting the message...*"). See column 5, lines 20-35. The reference provides a reasonable suggest of a manager with the responsibility of creating a list of recipients as well as time out preferences for each recipient (i.e. a document manager). All of the communication between the originator and recipients and between recipients and recipients is through normal email, which suggests a means of converting instruction into a message.

The reference does not explicitly state a second document manager in the server for modifying contents of the web document by receiving the message from the first document manager; however, Murakami discloses a document flow manager on the server side takes charge of the managements to determine which image data including document should be sent to each client. The document flow manager manages the flow of the stored image data included document to be circulated to the users in charge of processing according to the specified rule.

See column 7, lines 20-45. The reference suggests a document manager on the server side, which

is responsible for the dissemination of documents to a plurality of users. Within a client/server

environment it would have been common to find a document manager on both the client side and

server side to promote the ease of document management with a plurality of users. Therefore, it

would have been obvious to one of ordinary skill in the art, having the teachings of Everingham

and Murakami before him at the time the invention was made, to modify the document editing

methods of Everingham to include the server side document manager methods taught by

Murakami, because it would have provided a proficient means of preserving the document

history after being modified throughout the modifications.

**In reference to dependent claim 3**, Everingham teaches:

Each recipient in turn adds a status to the message and, when the recipient is finished, the

message is then routed to the next recipient in the list. A current version of the document is also

sent back to the manager. See column 3, lines 40-50.

**In reference to dependent claim 4**, Everingham teaches:

While the document is being routed, a module of the document routing program receives

a status message from one of the recipient computers and based on the status message, it is

determined if there is an error condition in the document routing among the recipient computers.

The reference does not explicitly state a second document manager in the server for modifying

contents of the web document by receiving the message from the first document manager;

however, Murakami discloses a document flow manager on the server side takes charge of the

managements to determine which image data including document should be sent to each client.

The document flow manager manages the flow of the stored image data included document to be

circulated to the users in charge of processing according to the specified rule. See column 7, lines 20-45. The reference suggests a document manager on the server side, which is responsible for the dissemination of documents to a plurality of users. Within a client/server environment it would have been common to find a document manager on both the client side and server side to promote the ease of document management with a plurality of users. Therefore, it would have been obvious to one of ordinary skill in the art, having the teachings of Everingham and Murakami before him at the time the invention was made, to modify the document editing methods of Everingham to include the server side document manager methods taught by Murakami, because it would have provided a proficient means of preserving the document history after being modified throughout the modifications.

**In reference to dependent claim 6**, Everingham teaches:

The invention uses the existing email functionality of the client's Internet browser. All of the communication between the originator and recipients and between recipients and recipients is through normal email. See column 6, lines 30-35.

**In reference to dependent claim 7**, Everingham teaches:

While the document is being routed, a module of the document routing program receives a status message from one of the recipient computers and based on the status message, it is determined if there is an error condition in the document routing among the recipient computers. The reference does not explicitly state a second document manager in the server for modifying contents of the web document by receiving the message from the first document manager; however, Murakami discloses a document flow manager on the server side takes charge of the managements to determine which image data including document should be sent to each client.

The document flow manager manages the flow of the stored image data included document to be circulated to the users in charge of processing according to the specified rule. See column 7, lines 20-45. The reference suggests a document manager on the server side, which is responsible for the dissemination of documents to a plurality of users. Within a client/server environment it would have been common to find a document manager on both the client side and server side to promote the ease of document management with a plurality of users. Therefore, it would have been obvious to one of ordinary skill in the art, having the teachings of Everingham and Murakami before him at the time the invention was made, to modify the document editing methods of Everingham to include the server side document manager methods taught by Murakami, because it would have provided a proficient means of preserving the document history after being modified throughout the modifications.

**In reference to dependent claim 8 & 9**, Everingham teaches:

The document is reviewed, the manager makes final modifications, and sends the finished document to the person to whom the manager reports. The manager additionally has versions of the document available for each stage of the modification. See column 3, lines 53-60. Because the Everingham reference utilizes a MIME type messaging service it would have been obvious to one of ordinary skill in the art at the time the invention was made to inform and display to the user utilizing the MIME service after receiving the modification because it would have provided the manager a way of maintaining collaboration efforts with each of the plurality of users.

**In reference to independent claim 10**, the claim reflects the method comprising instructions used for performing the system as claimed in claim 1, and in further view of the following, is rejected along the same rationale.

**In reference to dependent claim 12**, Everingham teaches:

A recipient ID, a line number, which indicates a status report, number, and perform

recipient action, which maintains a users message related to editing. See column 5, lines 5-20.

**In reference to independent claim 15**, the claim reflects the computer-readable instructions

used for performing the methods as claimed in claim 1, and in further view of the following, is

rejected along the same rationale.

### *Allowable Subject Matter*

7.      Claims 5, 11, 13, and 14, are objected to as being dependent upon a rejected base claim,

but would be allowable if rewritten in independent form including all of the limitations of the

base claim and any intervening claims.


### *Response to Arguments*

8.      Applicant's arguments with respect to claims 1-15 have been considered but are moot in

view of the new ground(s) of rejection.

It is respectfully noted that applicant's incorporation of dependent claim 2 (rejected under

35 U.S.C. 103(a) into independent claim 1, changes the scope of the claim's limitations when

interpreted as a whole. Therefore, the instant rejections have been adjusted accordingly.

### *Conclusion*

9.      The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

Shimizu et al.,                    USPN 5,861,880                    filed (10.10.1995)

Applicant's amendment necessitated the new ground(s) of rejection presented in this

Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Matthew J. Ludwig whose telephone number is 571-272-4127.

The examiner can normally be reached on 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

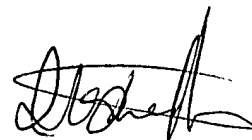supervisor, Stephen Hong can be reached on 571-272-4124.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications are available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ML
November 14, 2004

STEPHEN S. HONG
PRIMARY EXAMINER